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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,809	01/28/2002	Kazuyuki Hayashi	1417-380	7411

7590 02/13/2003

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EXAMINER
RESAN, STEVAN A

ART UNIT	PAPER NUMBER
1773	4

DATE MAILED: 02/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/055,809	HAYASHI ET AL.	
	Examiner	Art Unit	
	Stevan A. Resan	1773	

-- Th MAILING DATE of this communication appears on the cover sh et with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. *09/208,771* .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 18, and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The word "usually" makes the cited range meaningless since it does not limit to that range.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 18-32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by EP 0913431.

See paragraphs, 0040, 0048, 0067, 0068, 0100, claim 1. It appears that the carbon-coated particles of at least some of the examples would fall into the claimed range before desorbtion. It has been held that where claimed and prior art products are identical or substantially identical in structure or in composition, or are produced by identical or substantially identical processes a case of anticipation or a prima facie case of obviousness has been established and the burden of proof is shifted to applicant to show that prior art products do not necessarily or inherently possess the characteristic

of a claimed product whether the rejection is based upon "inherency" under 35 USC 102 or on "prima facie obviousness" under 35 USC 103 jointly or alternately. In re Best 562 F2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977); In re Ludke, 58 CCPA 1159,441 F 2d at 212-13, 169 USPQ 563 (1971); In re Brown, 59 CCPA 1036, 459 F. 2d 531, 173 USPQ 685 (1972). " When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not". In re Spada. 911 F2d 705, 709, 15 USPQ 2d 1655 (Fed. Cir. 1990)

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi et al U.S. 5,750,250 in view of EP 0913431.

Hayashi et al disclose a magnetic recording medium comprising a non-magnetic base film, a non-magnetic undercoat layer formed on the base film comprising a binder resin and non-magnetic acicular iron based composite particle and a magnetic coating film formed on the non-magnetic undercoat layer comprising binder resin and magnetic particles. The non-magnetic acicular iron based composite particles comprise acicular hematite particles having a major axis diameter of not more than 0.3 nm.

Hayashi does not disclose a coating layer of an organosilicon compound or a carbon black coat as claimed. However, the EP 0913431 document discloses the particle coatings as claimed and motivations to use these coatings on acicular hemitite particles i.e., to aide in the dispersion of the particles in a vehicle and to impart acid resistance to a coating containing the particles and aging resistance to the coating.

Therefore, it would have been obvious to one of ordinary skill in the art to employ the coated particles as disclosed in EPO 913431 in the underlayer of a magnetic recording medium optimizing the outer carbon black coating layer for a particular polarity binder resin, especially when a vinyl chloride type resin was used as the binder (since vinyl chloride resins produce HCL upon aging) in order to obtain a smoother surface on the underlayer due to better dispersion and a more stable layer over time. The dimension of the coated particle is deemed to fall into the claimed range and the limitations of dependent claims 2-17, 33-36 correspond to those disclosed in the '431 patent.

It appears, however, that patentable subject matter is present based upon the use of a myristic acid:butyl stearate lubricant system in the non magnetic layer. The amount of carbon black used enables the control of the myristic acid absorbtion to enable optimization of the media lubricity. If applicants will amend the claims to include the presence of myristic acid in the non-magnetic layer claims 1 and 33 would be deemed allowable.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stevan A. Resan whose telephone number is (703) 308-4287. The examiner can normally be reached on Tuesday-Friday from 7:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5436.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.

S.A. Resan
Feb 9, 2003

STEVAN A. RESAN
PRIMARY EXAMINER